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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,717	07/11/2001	Herbert Uram		6761

7590 10/06/2004

c/o ANTHONY CASTORINA  
SUITE 207  
2001 JEFFERSON DAVIS HIGHWAY  
ARLINGTON, VA 22202

EXAMINER

GANEY, STEVEN J

ART UNIT	PAPER NUMBER
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3752

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/901,717

Applicant(s)

URAM, HERBERT

Examiner

Steven J. Ganey

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. Receipt is acknowledged of the amendment filed on July 6, 2004, which has been fully considered in this action.

#### *Specification*

2. The amendment filed July 6, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows: a sea vehicle having capability of cooling water **on a large scale**.

Applicant is required to cancel the new matter in the reply to this Office Action.

#### *Claim Rejections - 35 USC § 101*

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-16 are rejected under 35 U.S.C. 101 because the disclosed invention is wholly inoperative and therefore lacking in credible utility. What has been disclosed is a concept more in the realm of speculation and conjecture than the reduction of an idea to a practical application based on science and technology.

Regarding claim 1, applicant claims a method of inhibiting or weakening the formation of hurricanes comprising detecting the onset of a hurricane in a region of open water and

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immediately cooling the surface water in the open water region. In order for an invention, process or otherwise, to have credible utility, the application disclosure must contain sufficient evidence and reasoning to permit a person of ordinary skill in the art to believe the asserted utility. In this case, the application does not contain sufficient information to permit a person of ordinary skill in the art to believe that the process disclosed could achieve the asserted useful result, since applicant has shown no evidence of reducing the speculation and conjecture to practice in either a laboratory or natural environment setting.

Regarding claim 11, applicant claims a submarine including a water pump constructed such that its operation, upon detection of the onset of a hurricane, is effective to utilize the cooler water at said depth of the open water region to cool the water at the surface of the open water region. Again, as in claim 1, the application disclosure does not contain sufficient evidence and reasoning to permit a person of ordinary skill in the art to believe that the asserted utility or that the process disclosed could achieve the asserted useful result, since applicant has shown no evidence of reducing the speculation and conjecture to practice in either a laboratory or natural environment setting.

On the issue of compliance with the utility requirement of 35 U.S.C. 101, the following statement made by the Supreme Court of the United States is on point:

“This is not to say that we mean to disparage the importance of contributions to the fund of scientific information short of the invention of something “useful”, or that we are blind to the prospect that what now seems without “use” may tomorrow command the grateful attention of the public. But a patent is not a hunting license. It is not a reward for the

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search, but compensation for its successful conclusion. "[A] patent system must be related to the world of commerce rather than to the realm of philosophy."

See, Brenner v. Manson, 148 USPQ 689, 696 (US SupCt 1966).

*Claim Rejections - 35 USC § 112*

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The standard for enablement is whether a person skilled in the art would have sufficient information from the application disclosure to make and use the claimed invention without undue experimentation. In this case, the amount of experimentation necessary to use the process disclosed would be undue. Undue experimentation would be necessary because:

- The claimed invention is broad and sweeping in scope.
- The nature of the invention is that of a large-scale environmental change.
- The state of the prior art offers no reasonable background from which to judge the feasibility of the invention.

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- The level of one of ordinary skill in this art is best characterized as that of a theoretical scientist dealing in probabilities and possibilities rather than that of an engineer dealing in practical applications of technology.
- The outcome of the disclosed concept is entirely unpredictable.
- The application is devoid of working examples.
- The quantity of experimentation needed to use the invention based on the content of the disclosure can only be characterized as astronomical considering the lack of background information, past experimentation, and specific detail.

7. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification is silent to the recitation of "a sea vehicle having capability of cooling water **on a large scale**".

#### *Response to Arguments*

8. Applicant's arguments filed March 4, 2004 have been fully considered but they are not persuasive.

In response to applicant's arguments that the Claims 1-16 are patentable under 35 U.S.C. 101, note that the examiner still maintains that the application disclosure does not contain sufficient evidence and reasoning to permit a person of ordinary skill in the art to believe that the asserted utility or that the process disclosed could achieve the asserted useful result, since

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applicant has shown no evidence of reducing the speculation and conjecture to practice in either a laboratory or natural environment setting. Applicant has not presented any evidence to support the assertion of a credible utility, only speculation and conjecture. As to Girdon reinforcing applicant's arguments, note that only one credible utility is required in a patent application. In the case of Girdon, there are other utilities disclosed besides preventing a hurricane that have credible utility(i.e. the use of Girdon's invention to combat water pollution or to eliminate ice or prevent its formation). Further reinforcing the examiner's position is the fact that Girdon does not claim an apparatus or method for preventing a hurricane.

In response to applicant's arguments that the specification meets the enabling requirement and the best mode requirement of 35 U.S.C. 112, first paragraph, note that applicant has not presented adequate evidence that the disclosure as filed would enable the claimed invention for one skilled in the art at the time of filing.

### *Conclusion*

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven J. Ganey whose telephone number is (703) 308-2585. The new phone number for the Alexandria, VA office is 571-272-4899, which will become effective November 22, 2004. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mar, can be reached on (703) 308-2087. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

sjg

10/4/04

  
STEVEN J. GANEY  
PRIMARY EXAMINER  
10/4/04